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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,844	05/07/2002	Robert Benjamin Franks	5897-000009	4210
27572 7590 09/22/2009 HARNESS, DICKEY & PIERCE, P.L.C. P.O. BOX 828 BLOOMFIELD HILLS, MI 48303				
EXAMINER RUHL, DENNIS WILLIAM				
ART UNIT		PAPER NUMBER		
3689				
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09/22/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/030,844

**Applicant(s)**

FRANKS ET AL.

**Examiner**

Dennis Ruhl

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 July 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 33-65 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 33-65 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SE/US)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

Applicant's response of 7/8/09 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 33-38,49-53,60,62,63,65, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

For claims 33-38,60,63, the claims appear to be directed to software per se. All of the claimed elements are written in terms of means plus function limitations. Upon consulting the specification for guidance on the scope of these terms, it appears that applicant has defined the means in terms of a pull down menu, or a box, or a scroll bar, or highlighting. All of these things are not real world things but are computer software or programming. The scope of the means language includes software alone, which renders the claims as non-statutory.

For claims 49-53,62,65, applicant has recited an "interface". When viewed in this terms broadest reasonable interpretation and when viewed consistent with the specification, the claimed display appears to read on the software itself as far as a display goes. Applicant is not claiming a display like a computer monitor because applicant did not disclosed anything about a computer monitor being the invention. The invention is disclosed as being software for assisting in the formulation of a trademark application. The examiner does not believe that the scope of these claims includes any hardware and because of this the claims are not considered to be statutory.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 34-38, 52, are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

For claims 34-37, applicant is reciting that the claimed means limitations comprises "use of ...". In an apparatus type of claim where real world structure is given weight when claimed, it is not clear what is meant by trying to recite structure by reciting that the recited structure is actually the use of an element. This does not make any sense as far as what is being claimed. In these claims the recited means limitations are supposed to be directed to tangible structure of some kind. These claims are reciting the claim structure as being a use, but these claims are not method claims. It is not clear if structure to an apparatus is being claimed or if a step of using a drop down menu, or using a box, or using scroll bar window, etc. is being claimed. These claims are considered indefinite.

For claim 38, with respect to the language of "whereby said user of said system selects said....by highlighting" and "whereby said user of said system selects...by underlining..", this appears to be a recitation to a method step in an apparatus type of claim. It is not clear to one wishing to avoid infringement whether or not the structure recited in the claims is needed to infringe, or if having the claimed structure and using it in the claimed manner would be infringement. This is not clear.

For claim 52, there is no antecedent basis for "said menu dialogue" as this has not previously been claimed. What does this refer to?

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 33,34,36,37,39,40,43,47,49-57,59-65, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Trademark/Service Mark Application, Principal Register, with Declaration" eTEAS Version 1.2(a), referred to as ETAS, in view of Atkinson (4931783).

For claims 33,34,36,39,40,43,47,49,50-57,59-65, ETAS discloses an online trademark filing application that can assist an individual with the online electronic filing of a trademark application. Inherent to this system is a processor and memory as

claimed. It cannot work without stored data, a processor, and a memory. It is noted by the examiner that the application has a section for the user to fill out the "Listing of Goods and/or Services" in sections 1(a) or 1(b). The trademark application requires that the applicant list the "Class code" and the "goods or services code". These are equated to the claimed "class headings" and the "list of goods/services" that applicant has claimed. The class headings are the class codes that the United States Patent and Trademark offices uses in their trademark classification scheme. There are also codes for the goods and services within each class code. The data entry fields are interactive and allow for use modification of entered values.

Not specifically disclosed in ETAS is that the user is presented with a means for presenting a predetermined list of goods or services that are in accordance with the official USPTO classification system. It is noted that in the online application there is the use of what are known in the art as drop down menus. See the fields for State and Country where a drop down menu is shown.

Atkinson discloses an invention that deals with drop down menus in computer displays and discloses a method to remove one. The examiner is not really citing Atkinson for that feature but the examiner notes that in the Background section it is disclosed that the use of pull down menus (which is a drop down menu) is well known in the art. It is disclosed that the menu is listed by "menu titles" which are the categories or headings that identify what that particular pull down menu represents. Then when the user selects that particular menu heading, a menu window is displayed that shows the user the available options to choose from. The use of drop down menus and

windows that allow a user to view the possible choices they can choose from is old and very well known in the art. In support of this position the examiner takes official notice of the fact that in Windows operating system, it is well known that you can list programs by clicking on a particular category, and then options are displayed such as all the folders or programs that are stored on the computer. One can click on the programs button, have a second window shown to them with the heading of accessories, and then what that is clicked on, another menu opens that shows the user their choices within that accessories menu heading. The use of headings in pull down menus is old and well known in the art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the user with a drop down menu for the various class codes (the claimed class headings) as well as for the listing of goods and/or services, so that the user is presented a menu from which they can choose from the number of available options that they can choose from. This is just taking the well known feature of a pull down menu and using it for the data entry portion of the application that deals with the class codes and the listing of goods/services codes. In ETAS, it already provides one of ordinary skill in the art with the motivation to do such a modification because the data entry for the State and Country are disclosed as being done via a drop down menu. For one of ordinary skill in the art to take that idea that was used for the State and County, and use it for another data field in the same application that also has a finite number of choices, which is what the USPTO Trademarks classification system has, this is just using the drop down menu concept for the known advantages it is already known to provide. This does not appear to a

difference that would involve more than ordinary skill in the art to come up with. ETAS itself provides strong motivation due to the application already using drop down menus, but in view of Atkinson as well, the invention is found to have been obvious to one of ordinary skill in the art. With respect to the highlighting feature of claim 38, this is part of the drop down menu. When you put the cursor over your choice, it is highlighted. That is an old and well known part of a pull down or drop down type of menu.

For claim 36, the textual choices in a pull down menu are icons and satisfy what is claimed. An icon is such a broad term that it includes textual icons.

For claim 37, not specifically disclosed is that a box is used for the user to make their selection. The use of boxes to indicate a person's choice is old and well known in the art. In fact, the application itself on page 1 has a box that is to be checked by the applicant. There are also circles that can be selected depending on which one applies to your situation. This is equated to and is the same concept as checking a box. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have the presentation means be in the form of a box that the user can use to indicate their selection. This is notoriously old and well known in the art, and is disclosed in ETAS itself.



8. Claims 33,35,39,42,44-49,60-65, are rejected under 35 U.S.C. 103(a) as being unpatentable over "Trademark/Service Mark Application, Principal Register, with Declaration" eTEAS Version 1.2(a), referred to as ETAS, in view of Ishikawa (5506951).

For claims 33,35,39,42,44,45,46,47,49,60-65, ETAS discloses an online trademark filing application that can assist an individual with the online electronic filing of a trademark application. It is noted by the examiner that the application has a section for the user to fill out the "Listing of Goods and/or Services" in sections 1(a) or 1(b). The trademark application requires that the applicant list the "Class code" and the "goods or services code". These are equated to the claimed "class headings" and the "list of goods/services" that applicant has claimed. The class headings are the class codes that the United States Patent and Trademark offices uses in their trademark classification scheme. There are also codes for the goods and services within each class code. The data entry fields are interactive and allow for use modification of entered values.

Not specifically disclosed in ETAS is that the user is presented with a means for presenting a predetermined list of goods or services that are in accordance with the official USPTO classification system. It is noted that in the online application there appears to be the use of what are known in the art as a scroll bar window. See the fields for the name and citizenship of all General partners, which is found on page 1. Other data fields also seem to show the use of a scroll bar window.

Ishikawa discloses an invention that deals with scroll bar windows in computer displays for displaying options to a user. In the Background section it is disclosed that many system provide for the use of scroll bars so that scrolling of previously hidden data is possible. This allows for a large amount of data to be displayed in a smaller window where the user can scroll through the data by way of up and down arrows in a scroll window. There is also a bar that represents where in the data the current window view of found. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the user with a scrolling bar window/menu for the various class codes (the claimed class headings) as well as for the listing of goods and/or services, so that the user is presented a scrolling menu from which they can choose any of their available options. This is just taking the well known feature of a scroll bar window and using it for the data entry portion of the application that deals with the class codes and the listing of goods/services codes. In ETAS, it already provides one of ordinary skill in the art with the motivation to do such a modification because the data entry for the General Partners are disclosed as being done via a scroll bar window. For one of ordinary skill in the art to take that idea that was used for the General Partner data field, and use it for another data field, this is just using the scroll bar window concept for the known advantages it is already is known to provide. This does not appear to a difference that would involve more than ordinary skill in the art to come up with. ETAS itself provides strong motivation due to the application already using scroll bar windows, but in view of Ishikawa as well, the invention is found to have been obvious to one of ordinary skill in the art.

For claim 48, the claimed information is disclosed as being asked for in the Trademark application of ETAS. The country is asked, this has already been addressed. It is presented in English which is the official language of the United States which is where the application is being filed.

9. Claims 53,58, is rejected under 35 U.S.C. 103(a) as being unpatentable over ETAS in view of Atkinson and further in view of Eisen et al. (5523754).

Not disclosed is that upon selecting the country, the forms are displayed in that countries language. Eisen discloses that it is known in computer programming and applications to allow the user to select the language that the display is to show. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide ETAS with the ability to take in the country whose language the use would like the display to be displayed in. This would allow for different users who speak and read different languages to use the system but also be able to have a better user experience. Simply modifying ETAS to display the data in different languages is considered to be an obvious modification that one of ordinary skill in the art appreciate and understand.

10. Claim 48 is rejected under 35 U.S.C. 103(a) as being unpatentable over ETAS in view of Ishikawa and further in view of Eisen et al. (5523754). This is an alternate interpretation for claim 48.

Not disclosed is that upon selecting the country, the forms are displayed in that country's language. Eisen discloses that it is known in computer programming and applications to allow the user to select the language that the display is to show. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide ETAS with the ability to take in the country whose language the user would like the display to be displayed in. This would allow for different users who speak and read different languages to use the system but also be able to have a better user experience. Simply modifying ETAS to display the data in different languages is considered to be an obvious modification that one of ordinary skill in the art appreciates and understands.

11. Applicant's arguments with respect to claims 33-65 have been considered but are moot in view of the new ground(s) of rejection.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 571-272-6808. The examiner can normally be reached on Monday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on 571-272-6805. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Dennis Ruhl/  
Primary Examiner, Art Unit 3689